



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/595,814	06/16/2000	Daniel Schreiber	5016	6584

7590 10/20/2004

MARC A. SOCKOL
SQUIRE, SANDERS & DEMPSEY L.L.P.
600 HANSEN WAY
PALO ALTO, CA 94304-1043

EXAMINER

YUAN, ALMARI ROMERO

ART UNIT	PAPER NUMBER
----------	--------------

2176

DATE MAILED: 10/20/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/595,814	Applicant(s) SCHREIBER ET AL.	
	Examiner Almari Yuan	Art Unit 2176	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
 - If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
 - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
 - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 14 June 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-5 and 19-21 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-5 and 19-21 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This action is responsive to communications: Amendment filed on 6/14/04.
2. Claims 1-5 and 19-21 are pending in the case. Claims 1 and 19 are independent claims.

Priority

3. Acknowledgment is made of applicant's claim for foreign priority based on an application filed in Israel on 6/14/1998. It is noted that Applicant has not filed a certified copy of the 124895 application as required by 35 U.S.C. 119(b). It is also noted that Applicant has stated that the certified copy can be located in the parent case (see remarks on page 5, 3rd paragraph from the Amendment filed on 12/01/03).

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. **Claims 1-2, 4-5, and 19-20 rejected under 35 U.S.C. 103(a) as being unpatentable over Marmor (USPN 6,601,108 B1 – provisional filed on 03/1997) in view of Sato (USPN 6,055,530 – filed on 03/1998).**

Regarding independent claims 1 and 19, Marmor discloses:

A method for providing textual information in a network environment, the method comprising:

Art Unit: 2176

receiving at a server connected to a network from a computer terminal connected to said network, a request via said network for text-editable data; sending said non-text-editable data via said network from sever to said computer terminal (Marmor on col. 4, lines 35-41 and col. 5, lines 26-43: teaches client downloads (request) information from the server; the requested information can be sent by the server);

converting said text-editable data into a non-text-editable data upon receiving said request (Marmor on col. 5, lines 3-17: teaches converting text data into an image data (for example a GIF format data) to be displayed on the client).

Furthermore, Marmor discloses "sending text-editable data". Marmor has the capability of processing data between client and server into data that is useable by the client and useable by the server, in other words, the data can be textual data or image data depending on the standards of the client computer (see col. 4, lines 35-41 and col. 5, lines 5-7).

However, Marmor does not explicitly disclose "determining whether said text-editable data is stored in a first storage area of said server that is inaccessible to said computer terminal or in a second storage area of said server that is accessible to said computer terminal".

Sato discloses storing text files in the database 30c (see col. 4, line 66 – col. 5, line 2, Figure 3) and storing image files in the hard disk 30d or the hierarchical storage 32 (see col. 5, lines 3-15). The WWW server 30a, ...executes the search of text files stored in the database 30c (col. 8, lines 40-42). The CGI program 30 ...acquires an image file... that corresponds to the text file obtained by search the database (col. 8, lines 55-59). The WWW server 30a transfers the image file acquired from the hard disk 30d to the personal computer 40 (see col. 9, lines 36-

Art Unit: 2176

38. In other words, the text file is not accessed by the user (inaccessible) and the image file is transferred to the personal computer being accessible.

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to have modified Sato into Marmor to provide a storage for text files and a storage for the image files and wherein the image files is only transferred to the personal computer, as taught by Sato, incorporated into the data and image files of Marmor, in order to facilitate the search operation in the server.

Regarding dependent claims 2 and 20, Marmor discloses:

a non-text-editable graphical representation of said text-editable data (on col. 5, lines 3-17: teaches the conversion of text data into an image data; wherein the image data can be a GIF format data).

Regarding dependent claim 4, Marmor discloses:

displaying said non-text-editable data via a computer terminal display (on col. 5, lines 8-11: teaches converted image files for display on the client).

Regarding dependent claims 5, Marmor discloses:

computer terminal connected to said network at a server (see figures 1A-1B), converting performed at said server (on col. 5, lines 3-17: teaches all data from the server is converted into data usable by the client), server sending said non-text-editable information to said computer terminal via said network (on col. 4, lines 35-41 and col. 5, lines 3-44, see figures 1A-1B: teaches the server can send converted data to the client when the client request download of an information).

Art Unit: 2176

6. **Claims 3 and 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Marmor and Sato as applied to claims 1-2, 4-5, and 19-20 above, and further in view of LeMole et al. (USPN 6,009,410 – filed on 10/1997).**

Regarding dependent claims 3 and 21, Marmor and Sato disclose the invention substantially as claimed as described *supra*. However, Marmor and Sato do not explicitly disclose “graphical representation comprises at least one hyperlink”.

LeMole on col. 2, lines 28-33, see Abstract: teaches user can click on image to retrieve through hyperlink further information; images, banners, etc. are user for presenting textual and/or visual information.

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to have modified LeMole into Marmor and Sato to provide a hyperlink with an image as taught by LeMole, incorporated into the converted image data of Marmor and Sato, in order to enhance the presentation of information to be displayed to a user on the Web.

Response to Arguments

7. Applicant's arguments filed 06/14/04 have been fully considered but they are not persuasive.

Regarding Applicant's remarks on page 6:

Marmor is a method for transferring information between a server and a client through a converter (see Abstract). Marmor discloses converting text data into image data such as GIF format depending on the capabilities of the client (col. 5, lines 3-17) and can also transfer textual

Art Unit: 2176

data depending on the standards of the client computer (see col. 4, lines 35-41 and col. 5, lines 5-7).

Sato discloses having the capability of transferring data that is stored in the document accumulation unit 12 comprising a plurality storage areas storing text files and image files (see col. 7, lines 7-13); the client submits a search request to acquire an image file; wherein the search is performed on the text files; and acquiring an image file from the storage 32 corresponding to the text file obtained by searching the database 30c (on col. 8, lines 40-67). The selected image file is stored into the cache area to be read at a higher speed than storage 32 (col. 8, lines 60-67).

Conclusion

8. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.


Art Unit: 2176

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Almari Yuan whose telephone number is 703-305-5945 (571-272-4104 after October 20, 2004). The examiner can normally be reached on Mondays - Fridays (8:30am - 5:00pm).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph Feild, can be reached on 703-305-9792 (571-272-4090 after October 20, 2004). The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

AY
October 17, 2004


SANJIV SHAH
PRIMARY EXAMINER